

RECEIVED
CENTRAL FAX CENTER

DEC 28 2006

Serial No. 10/813,633
Docket No. PTGF-03090
Reference No. HIR.099**REMARKS**

Entry of this amendment is deemed proper since no substantive amendments have been made to the claims, and no new claims are presented.

Claims 5-27 are all the claims presently pending in the application. Claims 1-4 were drawn to a non-elected invention and previously were canceled. Claims 5, 14, and 25-27 have been amended to improve their form and to more particularly point out the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to or cancellation of any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended or canceled claim.

Objections to claims 25 and 27 are presented in the outstanding Office action. Applicants have amended the claims as indicated in the Office action. Withdrawal of the objections respectfully is requested.

Claims 5-13 and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,769,798 to Mishimagi in view of U.S. Pat. No. 6,674,096 to Sommers. Claims 14-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mishimagi in view of U.S. Pat. No. 5,865,529 to Yan.

The rejections respectfully are traversed in the following discussion.

I. THE CLAIMED INVENTION

In the invention recited in claim 5, a rearview mirror apparatus for a vehicle includes a housing that has a mirror disposed on a back side of the housing. An LED includes a light emitting element and plane-radiates light in a direction nearly vertical to the optical axis of the light emitting element. A light guiding member is attached to the housing such that the light guiding member is exposed in an opening formed at part of the outer surface of the housing. The LED is disposed in the light guiding member. The light guiding member allows the plane-radiated light to be transmitted through the light guiding member and to be reflected on

Serial No. 10/813,633
Docket No. PTGF-03090
Reference No. HIR.099

an inner surface of the light guiding member to be radiated in a desired direction.

Further, with the LED being disposed in the light guiding member as recited in claim 5, a light component emitted backward from the LED can be reflected toward the forward or lateral direction by a rear inner surface of the light guiding member located back of the LED (See FIG. 4 of the application, for example). As such, the light component can be efficiently utilized to increase a total amount of radiated light.

In the invention recited in claim 14, a rearview mirror apparatus for a vehicle includes a housing that has a mirror disposed on a back side of the housing. An LED includes a light-emitting element and radiates light in an optical axis direction of the light emitting element and in a direction nearly vertical to the optical axis direction of the light emitting element. A reflector that is disposed along the shape of the housing at part of the outer surface of the housing has at least one reflection surface which allows light radiated from the LED disposed in the reflector to be reflected in the front or side direction of the vehicle.

II. THE PRIOR ART REJECTIONS

A. The Mishimagi and Sommers References - Claims 5-13:

Mishimagi discloses a cover lamp for a side view mirror. The cover lamp includes an LED 27. LED 27 does not plane-radiate light in a direction nearly vertical to the optical axis of the light emitting element.

More specifically, FIG. 1 of Mishimagi discloses that LED 27 includes light emitting elements 27a emitting light toward the front, and light emitting elements 27b emit light toward the side. The direction of light emission is indicated in FIG. 1 by small arrows, the tails of which are anchored near the light emitting elements 27a and 27b.

Thus, FIG. 1 and the associated discussion of Mishimagi teach that LED 27 does not plane-radiate light that is nearly vertical to the optical axis of the light emitting element. Instead, Mishimagi teaches that LED 27 emits light nearly parallel to the optical axis of the light emitting element. Claim 5 is patentable over Mishimagi.

Sommers does not remedy the deficiencies of Mishimagi, such as those noted above. Sommers is cited as providing the plane-radiating light emitting element admitted by the

Serial No. 10/813,633
Docket No. PTGF-03090
Reference No. HIR.099

Office to be missing from Mishimagi. The Office alleges that it would have been obvious to incorporate such a plane-radiating element as disclosed in Sommers into the invention of Mishimagi.

Applicants respectfully disagree, noting that Mishimagi teaches a side mirror cover for allowing illumination of a plurality of lamps to be visible over a wide range. The lamp disclosed in Mishimagi has a lamp housing having plural light emitting elements. As shown in FIG. 1 of Mishimagi, first and second light emitting elements (27a, 27b) emit light toward the front and the side of the vehicle, respectively. Moreover, the inner surface of the lamp cover has a projected portion facing the second light emitting element 27b. The lamp cover has concavities and projections provided to reflect light from axially-emitting lamps. The second light emitting element 27b specifically is provided to illuminate toward the side and rear of the automobile.

The rejection of claim 5 based on combining Sommers into Mishimagi requires replacement of the first and second light emitting elements by the plane-radiating light taught by Sommers. As discussed further below, the modification of Mishimagi required for the proposed combination of the references runs contrary to the fundamental teachings of Mishimagi, and destroys the advantages espoused by Mishimagi with respect to the first and second light emitting elements.

Mishimagi teaches a side view mirror lighting device specifically designed for at least two axially-radiating LED lamps. The cover structure takes advantage of the axially-radiated light in guiding the light from light emitting element 27b to illuminate to the sides and rearward of the vehicle. There is no logical reason to replace the axially-radiating lamps utilized in Mishimagi with the plane-radiating lamps that are taught by Sommers. Instead, the proposed combination of the references would change the principals of operation of Mishimagi. The two lamps-types are not interchangeable according to the teachings of Mishimagi. In order to illuminate the side view mirror as intended by Mishimagi using the lamp disclosed by Sommers a complete redesign of the light guide of Mishimagi would be required.

Serial No. 10/813,633
Docket No. PTGF-03090
Reference No. HIR.099

Further, Applicants respectfully submit that the motivation advanced by the Office for the proposed combination of references has no support in the references or anywhere else. Instead, one of ordinary skill in the art would be motivated against replacing the first and second light emitting devices of Mishimagi with the plane-radiating lamp of Sommers.

The Office alleges that using the lamp disclosed by Sommers would simplify the rear view mirror assembly by eliminating the need for an additional support portion perpendicular to the light guiding member. The support holds the second light emitting element 29b, as seen in FIG. 1 of Mishimagi. Apparently, the Office intends to eliminate the second light emitting element 29b, which would be directly contrary to the teachings of Mishimagi. Applicants therefore note that the lamp disclosed by Sommers must be mounted horizontally in order for light from the plane-radiating lamp to radiate toward the front and side of the automobile.

More specifically, as seen in FIGS. 1 and 3 of Mishimagi, mounting the lamp disclosed by Sommers in the same orientation as the lamps 27a disclosed by Mishimagi would result in light being emitted only to the sides (and top and bottom) of the side view mirror: No light would radiate forward of the vehicle. Similarly, mounting the lamp disclosed by Sommers in the same orientation as the lamp 27b disclosed by Mishimagi would result in no light being emitted to the side of the vehicle.

In order to illuminate forward, and to the side, of the vehicle, the lamp disclosed by Sommers must be mounted horizontally in the housing disclosed by Mishimagi. Mounting the lamp disclosed by Sommers horizontally would require, at the very least, providing an additional, horizontal support structure, as can be seen in FIG. 3 of Mishimagi.

Further, assuming, *arguendo*, that the lamp disclosed by Sommers could be mounted in the housing of Mishimagi, Applicants submit that much of the light emitted by the plane-radiating lamp disclosed by Sommers would not radiate onto the reflective lamp cover. This, combined with the reduction in the number of lamps, would lead to reduced light output from the side mirror cover, and to no expectation that the light would be successfully directed around the side and toward the back of the mirror as intended in Mishimagi.

Consequently, no simplification is seen to result from the proposed combination. No other motivation to combine the references is evident beyond the improper use of hindsight to

Serial No. 10/813,633
Docket No. PTGF-03090
Reference No. HIR.099

build the present invention out of the prior art references using Applicants' disclosure as a blueprint. Lacking proper motivation, the Office fails to establish *prima facie* obviousness.

Claim 5 is patentable over Mishimagi in view of Sommers. Claims 6-13 and 24-25 depend directly or indirectly from claim 5, and are patentable over Mishimagi in view of Sommers for at least the same reasons.

B. The Mishimagi and Yan References - Claims 14-23:

The Office action alleges that Mishimagi discloses all limitations of independent claim 14, except the LED plane-radiating light in a direction nearly vertical to the optical axis of the light emitting element. Applicants agree that this limitation is not taught by Mishimagi. Applicants respectfully urge, however, that Mishimagi does not disclose all other limitations of claim 14.

More specifically, Mishimagi discloses LEDs that emit light along their optical axes toward a lamp cover. The lamp cover disclosed by Mishimagi, however, is not a reflector that has at least one reflection surface which allows light plane-radiated from the LED disposed in the reflector to be reflected in the front or side direction of the vehicle.

Supplying the LED lamp of Yan does not cure the deficiencies of Mishimagi. Yan does not provide a reflector that has at least one reflection surface which allows light plane-radiated from the LED disposed in the reflector to be reflected in the front and side directions of the vehicle.

In addition, incorporation of the LED lamp disclosed by Yan into Mishimagi suffers from the same drawbacks as does the LED lamp disclosed by Sommers and discussed above. Mishimagi teaches a cover specifically designed for at least two axially-radiating lamps. There is no motivation for the proposed combination.

Claim 14 is patentable over Mishimagi in view of Yan. Claims 15-23 depend directly or indirectly from claim 14, and are patentable over Mishimagi in view of Yan for at least the same reasons.

RECEIVED
CENTRAL FAX CENTER

DEC 28 2006

Serial No. 10/813,633
Docket No. PTGF-03090
Reference No. HIR.099

III. FORMAL MATTERS AND CONCLUSION

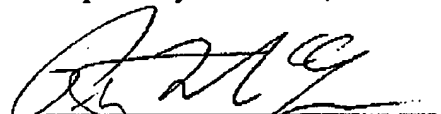
In view of the foregoing, Applicants submit that claims 5-27, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the application be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 28 Dec 2006



Peter F. McGee, Esq.
Registration No. 35,947
Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment Under 37 CFR §1.116 by facsimile with the United States Patent and Trademark Office to Examiner Ismael Negron, Group Art Unit 2875 at fax number (571) 273-8300 this 28th day of December, 2006.



Peter F. McGee, Esq.
Registration No. 35,947